



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/355,946	08/16/99	NAKAMURA	M P7318-9007

IM52/1105
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EXAMINER	
GALLAGHER, J	
ART UNIT	PAPER NUMBER
1733	//

DATE MAILED: 11/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Remanded

Office Action Summary

Application N

09/355946

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10 AUGUST 2001
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
- Of the above claim(s) 1-4 and 9-10 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 5-8 and 11-12 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-12 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☒ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The disclosure is objected to because of the following informalities: (a) Page 8 line 12 - delete "the" (as being unnecessary); (b) page 12 line 25 - "oriented" should read "orientation"; (c) page 23 lines 4 and 10 and page 58 line 17 - insert "range" after "°C"; (d) page 27 line 17 - change "molting" to "melting" (unless, of course, the polyolefin sheets are in the form of birds); (e) page 29 line 3 - change "heat treated" to "preheated", and delete "once"; (f) page 33 line 7 - "FUNCTIONS" not understood (perhaps "Industrial Applicability" or "Industrial Use" was intended); (g) page 34 line 4 and page 35 line 12 - delete "a" before "sheet" (as being unnecessary); and (h) page 38 line 19 - change "EXAMPLES" to "EMBODIMENTS".

Appropriate correction is required.

2. Paragraph 2 of the last Office action is hereby reiterated.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 5, 7-8 and 11-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Rasmussen or Caiola et al.

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over either Rasmussen or Caiola et al., each in view of Iverson.

6. Applicants' arguments filed 10 August 2001 have been fully considered but they are not deemed to be persuasive. The foregoing art rejections are adhered to essentially for the reasons of record (see paragraphs 5 and 7 of the last Office action), with the following being additionally advanced in response to applicants' contentions made in the amendment: (a) The oriented polyolefin materials employed in the applied (primary) references to Rasmussen and Caiola et al. are held to be the same as those ^{ENVISIONED FOR} ~~in 3 and 4~~ use and claimed by applicants, consistent and in agreement with applicants' specification at (1)

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page 9 lines 7-11, wherein these art-disclosed materials are enumerated and exemplified; and (2) page 7 lines 13-19, wherein it is indicated that while UNORIENTED polyolefins exhibit/possess an average LEC of (generally) greater than 5×10^{-5} , orientation of such polyolefins results in/effects a change in average LEC to a value not exceeding 5×10^{-5} , such that it would apparently be incumbent upon applicants to demonstrate that the oriented polyolefins employed by Rasmussen and Caiola et al. do not indeed possess/exhibit the desired, envisioned average LEC value/property claimed i.e. AT LEAST a prima facie case of obviousness is felt/seen to have been made which (semantics aside) is seen NOT to have been effectively rebutted; further regarding all of the foregoing, N.B. paragraphs 1 and (especially) 2 of In re Fielder et al. 176 USPQ 300; and (b) with respect to the second art rejection (1) the Examiner is well aware that there is but one independent claim and (2) it is the sum total of the teachings of the applied, combined references taken as a whole which is held/seen to render applicants' invention obvious to one of ordinary skill in this art (In re McLaughlin 170 USPQ 209), and therefore applicants' piecemeal attack on the references individually cannot establish unobviousness, since this rejection is based upon a combination of references (In re Mapelsden 141 USPQ 30) i.e. this rejection is not overcome by pointing out that one reference does not

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contain a particular teaching when the reliance for that teaching was on another reference (In re Lyons, 155 USPQ 741) . In conclusion the gap (if any) between the envisioned, claimed invention and the teachings of the applied (and, where indicated, combined) references of record is held/seen to be simply not so great as to render the invention unobvious to one reasonably skilled in this art, any differences which might possibly/conceivably exist between this invention and these reference teachings being held/seen NOT to constitute patentable differences.

7. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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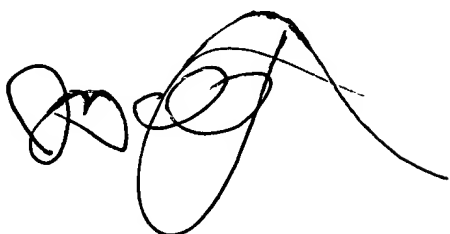
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.


JJGallagher:cdc

October 25, 2001


JOHN J. GALLAGHER
PRIMARY EXAMINER
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